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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/883,557	06/18/2001	Martin D. Koenig	4437-2	1087
26753 7590 12/19/2006 ANDRUS, SCEALES, STARKE & SAWALL, LLP 100 EAST WISCONSIN AVENUE, SUITE 1100 MILWAUKEE, WI 53202			EXAMINER KOPPIKAR, VIVEK D	
			ART UNIT 3626	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE			MAIL DATE	
3 MONTHS			12/19/2006	
			DELIVERY MODE PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/883,557

Applicant(s)

KOENIG ET AL.

Examiner

Vivek D. Koppikar

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 September 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-8 and 10-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-2, 4-8 and 10-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of the Application

1. Claims 1-2, 4-8 and 10-22 have been examined in this application. This communication is the first action on the merits since the applicants filed a Request for Continued Examination (RCE) on September 25, 2006.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-2, 4-8 and 10-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kessler in view of De La Motte in view of Partnering with School-Based Health Centers: Connecticut's Medicaid Managed Care Experience," (hereinafter referred to as Partnering) in view of Serko and in further view of Official Notice.

(A) As per claim 1, which is directed towards a method of providing a device, the cost of which is covered by a third party payor, to a health care facility and obtaining payment for the device from the third party payor, Kessler teaches the step of submitting a request for the device from the health care facility (102) to the third party payor (106) for authorization of payment (Section [0090]). The third party payor (106) is an insurance company in one embodiment (Section [0005]) and the third party payor (106), beneficiary (health care facility-(102)) and provider (manufacturer-(104)) are all interconnected through a network (Figure 1A and Section [0102]). The network in Kessler includes an application service provider (120) that contracts

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with providers to provide medical products (devices) and services (treatments), upon authorization, however this system is not a transaction facilitator (Kessler: Section [0121]).

De La Motte teaches a transaction facilitator which contacts a manufacturing facility to order a device (Sections [0039]-[0040]). Furthermore, De La Motte teaches a step in which the transaction facilitator generates a cost claim (invoice) for the device (Section [0049]). The supplier (manufacturer) delivers the device by hand delivery to the buyer (health care facility) in one embodiment (Section [0043]). The transaction facilitator in De La Motte is able to automate the product purchasing process by electronically exchanging and supplying the necessary documentation, certifications, communications, etc (De La Motte: Section [0052]). The examiner takes the position that the step of receiving payment at the transaction facilitator for the claim from a third party payor and transferring the funds from the transaction facilitator to the manufacturer (vendor) for payment of the device (good) is within the scope of the functions of the transaction facilitator contemplated by De La Motte.

At the time the invention was made, one of ordinary skill in the art would have been motivated to include a transaction facilitator (as taught in De La Motte) in the network of Kessler in order to have provided the beneficiary (health care facility-(102)) in Kessler with a more efficient means of linking to suppliers of products (devices) directly rather than through one or more levels of market intermediaries and in order to have broadened market participating of both buyers and supplies by exposing them to a global network of market participants (Section [0019]). In the combined system of Kessler in view of De La Motte, the examiner takes the position that it is within the scope of the combined system to have relayed the request for the

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quote (request for the device) from the third party payor (102) to the transaction facilitator since they are all interconnected by the network (Kessler, Figure 1A and Section [0102]).

Kessler in view of De La Motte do not teach the following feature which is taught in Partnering:

wherein a transaction facilitator (managed care) bills a third party payor (Medicaid) (without the facilitator billing the health care facility). (Partnering: Page 2, Lines 3-5). At the time of the invention, it would have been obvious for one of ordinary skill in the art to have modified the combined teachings of Kessler in view of De La Motte with the above mentioned teachings from Partnering with the motivation of complying with managed care policies, as recited in Partnering (Page 2, Lines 3-5).

The transaction facilitator in Partnering does not contact a manufacturer to purchase a device requested by a health care facility wherein there is no communication between the health care facility and the manufacturer, however, this is the function of a middleman which is well known in the procurement industry, as evidenced by Serko (Abstract). (Note: In Serko a middleman buys from a manufacturer and then resells a device to another party, however, it is within the scope of the procurement industry for a middleman to procure a device at the request of a user and then have the manufacturer directly ship that device to the user and the examiner takes Official Notice with respect to this feature, and at the time of the invention, it would have been obvious for one of ordinary skill in the art to have modified the combined teachings of Kessler in view of De La Motte and Partnering with the aforementioned teachings from the procurement industry with the motivation of providing a device to the end user wherein the end user would not be charged additional fees by the middleman since the device has been shipped

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directly to the user from the manufacturer rather than being resold from the middleman to the user at a higher price or markup.).

(B) As per claims 2 and 4-6, the rejection of these claims was set forth in the Office Action dated September 30, 2004 and is incorporated by reference herein.

(C) As per claim 7, this claim repeats features previously addressed in the rejection of claims1 and is rejected on the same basis.

(D) As per claims 8 and 10-12, the rejection of these claims was set forth in the Office Action dated September 30, 2004 and is incorporated by reference herein.

(E) As per claim 13, which is directed towards a method of providing a device for use with a patient, the cost of which is covered by a third party payor, to a healthcare facility, Kessler teaches the step of electronically submitting a request for a proposed treatment and a preferred device from the healthcare facility to the third party payer (Sections [0090] and [0121]). Furthermore, Kessler teaches the step of providing electronic authorization from the third party payor to the healthcare facility for the proposed treatment (Sections [0090] and [0121]).

Kessler fails to teach the step of relaying the request (for a proposed treatment) from the third party payor to a transaction facilitator (upon authorization) and utilizing a transaction facilitator to contact a manufacturer for the device to order the device. Kessler does teach an application service provider (ASP) (120) that contracts with providers to provide medical products (devices) and services (treatments), upon authorization, however this system is not a transaction facilitator (Kessler: Section [0121]).

De La Motte teaches a transaction facilitator which contacts a manufacturing facility to order a device (Sections [0039]-[0040]). Furthermore, De La Motte teaches a step in which the

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transaction facilitator generates a cost claim (invoice) for the device (Section [0049]). The supplier (manufacturer) delivers the device by hand delivery to the buyer (health care facility) in one embodiment (Section [0043]). The transaction facilitator in De La Motte is able to automate the product purchasing process by electronically exchanging and supplying the necessary documentation, certifications, communications, etc (De La Motte: Section [0052]). The examiner takes the position that the step of generating a claim for the device from the transaction facilitator to the third party payor) is within the scope of the functions of the transaction facilitator contemplated by De La Motte.

At the time the invention was made, one of ordinary skill in the art would have been motivated to include a transaction facilitator and a supplier network (manufacturer) (as taught in De La Motte) in the network of Kessler with the motivation of providing the beneficiary (health care facility-(102)) in Kessler with a more efficient means of linking to suppliers of products (devices) directly rather than through one or more levels of market intermediaries and in order to have broadened market participating of both buyers and supplies by exposing them to a global network of market participants (Section [0019]). In the combined system of Kessler in view of De La Motte, the examiner takes the position that it is within the scope of the combined system to have relayed the request for the quote (request for the device) from the third party payor (102) to the transaction facilitator since they are all interconnected by the network (Kessler: Figure 1A and Section [0102]).

Kessler in view of De La Motte do not teach the following feature which is taught in Partnering:

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wherein a transaction facilitator (managed care) bills a third party payor (Medicaid) (without the facilitator billing the health care facility). (Partnering: Page 2, Lines 3-5). At the time of the invention, it would have been obvious for one of ordinary skill in the art to have modified the combined teachings of Kessler in view of De La Motte with the above mentioned teachings from Partnering with the motivation of complying with managed care policies, as recited in Partnering (Page 2, Lines 3-5).

The transaction facilitator in Partnering does not contact a manufacturer to purchase a device requested by a health care facility wherein there is no communication between the health care facility and the manufacturer, however, this is the function of a middleman which is well known in the procurement industry, as evidenced by Serko (Abstract). (Note: In Serko a middleman buys from a manufacturer and then resells a device to another party, however, it is within the scope of the procurement industry for a middleman to procure a device at the request of a user and then have the manufacturer directly ship that device to the user and the examiner takes Official Notice with respect to this feature, and at the time of the invention, it would have been obvious for one of ordinary skill in the art to have modified the combined teachings of Kessler in view of De La Motte and Partnering with the aforementioned teachings from the procurement industry with the motivation of providing a device to the end user wherein the end user would not be charged additional fees by the middleman since the device has been shipped directly to the user from the manufacturer rather than being resold from the middleman to the user at a higher price or markup.)

(F) As per claims 14-20, the rejection of these claims was set forth in the Office Action dated September 30, 2004 and is incorporated by reference herein.

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(G) As per claims 21-22, in the combined method of Kessler in view of De La Motte the transaction facilitator is separate from the third party payor, as noted in the rejection of Claim 1 (De La Motte: Figure 1 and Kessler: Figure 1 A).

Response to Arguments

4. Applicant's arguments filed on September 25, 2006 with respect to the pending claims have been considered but are moot in view of the new grounds of rejection.


Conclusion

5. Any inquire concerning this communication or earlier communications from the examiner should be directed to Vivek Koppikar, whose telephone number is (571) 272-5109. The examiner can normally be reached from Monday to Friday between 8 AM and 4:30 PM.

If any attempt to reach the examiner by telephone is unsuccessful, the examiner's supervisor, Joseph Thomas, can be reached at (571) 272-6776. The fax telephone numbers for this group are either (571) 273-8300 or (703) 872-9326 (for official communications including After Final communications labeled "Box AF").


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Another resource that is available to applicants is the Patent Application Information Retrieval (PAIR). Information regarding the status of an application can be obtained from the (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAX. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, please feel free to contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Sincerely, 

Vivek Koppikar

11/28/2006


Robert Morgan
Patent Examiner
Art Unit 3626